

REMARKS

Applicant has cancelled Claims 2 and 3 and amended Claims 1 and 7. Applicant respectfully submits no new matter has been added by the present amendment. Support can be found generally throughout the text, specifically at page 2, lines 29 and 30 and in the Examples, formulations B and C. Applicant respectfully submits that it is for the inventor to decide what bounds of protection he will seek and he has the right to retreat to otherwise patentable subject matter because only part of what was originally claimed is patentable. In re Johnson, 194 USPQ 187, 195-96 (CCPA 1977).

I. Claim Rejection under 35 U.S.C. § 102(b)

Claims 1-7 and 9-12 stand rejected under 35 U.S.C. §102(b) in view of Mroczkowski (U.S. Patent No. 5,162,409). Applicant respectfully traverses this ground of rejection.

Applicant submits in order to anticipate a claim the cited reference **must teach each and every element of the claim**, either expressly or inherently. Applicant submits Mroczkowski fails to teach each and every element of the claimed invention.

Mroczkowski discloses an abrasion resistance halogenated isobutylene based rubber composition. Mroczkowski does not teach or suggest an elastomeric composition **comprising a natural rubber and bromobutyl rubber**, in the alternative in Table 1 Composition B (as cited in the Office Action) Mroczkowski only discloses a composition comprising bromobutyl rubber, SBR and BR (butadiene rubber). The only composition in Table 1 of Mroczkowski which includes natural rubber is composition A, which does not include bromobutyl rubber. Similarly, Column 3, lines 46-58 (as cited in the Office Action) does not disclose each and every element of the claimed composition. Column 3, discloses combining natural rubber with a synthetic rubber, but does not teach or suggest a composition comprised of a **halobutyl** elastomer, such as bromobutyl or chlorobutyl, and natural rubber.

For at least these reasons, Applicant respectfully submits Mroczkowski does not teach and every element of the claimed invention and accordingly does not anticipate the pending claims. Accordingly, Applicant requests withdrawal of this ground of rejection.

II. Claim rejection under 35 U.S.C. § 103(a)

Claims 8 and 13 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Mroczkowski in view of Standstrom, et al. (U.S. Patent No. 5,087,668). Applicant respectfully traverses this ground of rejection.

“To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught to suggested by the prior art. In re Royka, 490 F.2d 981, 180 USPQ 580 (Fed. Cir. 1974)”. Applicant also respectfully submits that “in order to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference. Second, there must be a reasonable expectation of success. Finally, the prior art references must teach or suggest all the claims limitations. The teachings or suggestions to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicants’ disclosure.” See MPEP § 2142, citing In re Vaeck, 947 F.2d 488, 20 USPQ 2d. 1438 (Fed. Cir. 1991).

As discussed above, Applicant submits, Mroczkowski does not teach and every element of the claimed invention and combination with Standstrom, et al. does not overcome the deficiencies of Mroczkowski.

Standstrom, et al. teaches a tire tread composed of a blend of 3,4-polyisoprene rubber, cis 1,4-polyisoprene rubber and at least one additional diene based rubber. Standstrom, et al. does not teach or suggest an elastomeric composition **comprising a natural rubber and halobutyl rubber.**

Despite the assertion in the Office Action, Column 10 discloses that a polymer blend of the Standstrom, et al. invention (i.e., 3,4-polyisoprene rubber, cis 1,4-polyisoprene rubber and at least one additional diene based rubber) can be adhered to various tire carcass substrates, such as a tread in the region of a

sidewall, may contain one or more butyl rubbers. Standstrom, et al. does not teach or suggest a elastomeric composition comprising a natural rubber and a halobutyl elastomer.

Further, Applicant submits, Standstrom, et al. does not teach or suggest a process as claimed in Claim 8 or a cured elastomer composition according to Claim 1 (an elastomeric composition comprising a natural rubber, a halobutyl elastomer, a mineral filler, and a rubber-mineral filler bonding agent, wherein the halobutyl elastomer is a bromobutyl elastomer, a chlorobutyl elastomer or a mixture thereof, wherein the mineral filler is silica and the bonding agent is a silane, wherein the composition does not include carbon black) in the form of an engine mount, a shoe sole or a diaphragm for a pump.

For at least these reasons, Applicant respectfully submits Standstrom, et al. does not teach and every element of the claimed invention and accordingly does not render the pending claims unpatentable. Accordingly, Applicant requests withdrawal of this ground of rejection.

III. Claim Rejection under 35 U.S.C. § 103(a)

Claim 12 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Mroczkowski in view of Jalics, et al. (U.S. Patent No. 5,708,053). Applicant respectfully traverses this rejection and incorporates his comments above.

As discussed above, Applicant submits, Mroczkowski does not teach and every element of the claimed invention and combination with Jalics, et al. does not overcome the deficiencies of Mroczkowski. Applicant further submits that neither Mroczkowski nor Mroczkowski in combination with Jalics, et al. teach or suggest an elastomeric composition **comprising a natural rubber and bromobutyl rubber** While Jalics, et al. discloses a list of rubber compounds which may be used in the silica filled rubber composition, it does not teach or suggest a composition for a truck tire as claimed, i.e. comprising **natural rubber and a halobutyl elastomer**. Applicant further submits, the Office Action provides no motivation for combining random rubbers listed in Jalics, et al. as claimed for use in a tire tread.

For at least these reasons, Applicant respectfully submits, Jalics, et al. does not teach and every element of the claimed invention and accordingly does not render the pending claims unpatentable. Accordingly, Applicant requests withdrawal of this ground of rejection.

IV. Claim Rejection under 35 U.S.C. § 103(a)

Claim 13 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Mroczkowski in view of Kausch, et al. (U.S. Patent No. 5,488,092). Applicant respectfully traverses this ground of rejection and incorporates his comments above.

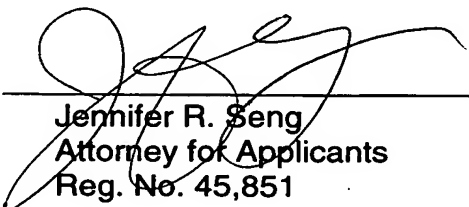
As discussed above, Applicant submits, Mroczkowski does not teach or suggest every element of the claimed invention and combination with Kausch, et al. does not overcome the deficiencies of Mroczkowski.

Applicant further submits that neither Mroczkowski nor Mroczkowski in combination with Kausch, et al. teach or suggest an elastomeric composition **comprising a natural rubber and bromobutyl rubber.**

While Kausch, et al. discloses a polyurethane composition can be applied to a film on any substrate wherein the surface of the substrate can be a natural rubber, SBR,butyl and halobutyl rubber, it does not teach or suggest a composition for an engine mount, a shoe sole or a diaphragm for a pump as claimed, i.e. comprising **natural rubber and a halobutyl elastomer.** Applicant further submits, the Office Action provides no motivation for combining random rubbers listed in Jalics, et al. as claimed for use in a tire tread.

For at least these reasons, Applicant respectfully submits, Jalics, et al. does not teach every element of the claimed invention and accordingly does not render the pending claims unpatentable. Accordingly, Applicant requests withdrawal of this ground of rejection.

Respectfully submitted,

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